

ESTTA Tracking number: **ESTTA629870**

Filing date: **09/29/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Dropbox, Inc.
Granted to Date of previous extension	09/28/2014
Address	185 Berry Street, Suite 400 San Francisco, CA 94107 UNITED STATES

Correspondence information	Susan L. Heller Greenberg Traurig, LLP 1840 Century Park East, #1900 Los Angeles, CA 90067 UNITED STATES linkerg@gtlaw.com Phone:3105867700
----------------------------	--

Applicant Information

Application No	86111135	Publication date	04/01/2014
Opposition Filing Date	09/29/2014	Opposition Period Ends	09/28/2014
Applicant	Zoosk, Inc. 989 Market Street, 5th Floor San Francisco, CA 94103 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2012/11/26 First Use In Commerce: 2012/11/26 All goods and services in the class are opposed, namely: computer and mobile phone application software, namely, software for use in communicating, transmitting, and sharing audio, video, photos, text and other digital content; downloadable computer and mobile phone software for online introduction, dating and social networking services
Class 042. First Use: 2012/10/24 First Use In Commerce: 2012/10/24 All goods and services in the class are opposed, namely: providing temporary use of nondownloadable software for use in communicating, transmitting, and sharing audio, video, photos, text and other digital content; providing temporary use of nondownloadable software for online introduction, dating and social networking services
Class 045. First Use: 2012/10/24 First Use In Commerce: 2012/10/24 All goods and services in the class are opposed, namely: online social networking services; online dating services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4330190	Application Date	08/31/2011
Registration Date	05/07/2013	Foreign Priority Date	NONE
Word Mark	CAROUSEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/05/10 First Use In Commerce: 2011/05/10 downloadable software, specifically forenabling viewing and sharing of photographs across internet-enabled devices		

U.S. Application No.	86250612	Application Date	04/12/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CAROUSEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/11/29 First Use In Commerce: 2006/11/29 Computer software used to organize and share photographs and graphical content and create virtual photo albums		

U.S. Application No.	86305245	Application Date	06/10/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CAROUSEL		

Design Mark	CAROUSEL
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Downloadable software, specifically forenabling viewing and sharing of photographs across internet-enabled devices; Computer software; computer software for use in connection with data, photos, images, audio, video, and multimedia content; Computer software for viewing, accessing, sorting, editing, manipulating, cataloguing, indexing, storing, syncing, uploading, downloading, sending, receiving, sharing, transferring, linking, tagging, streaming, and printing photos, images, graphics, videos, and other digital content, on, across, and via electronic devices, servers, global computer networks, and other communications networks; Computer software for creating, viewing, saving, accessing, sorting, editing, manipulating, uploading, downloading, sending, receiving, sharing, transferring, posting, blogging, linking, tagging, and streaming tags, albums, galleries, other metadata, electronic media, comments, messages, or other social information on, across, and via electronic devices, servers, global computer networks, and other communications networks

U.S. Application No.	86305250	Application Date	06/10/2014
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	CAROUSEL
Design Mark	CAROUSEL
Description of Mark	NONE
Goods/Services	Class 039. First use: First Use: 0 First Use In Commerce: 0 Electronic storage of data, photos, images, graphics, audio, videos, and other digital content; electronic storage of tags, albums, galleries, and other metadata; electronic storage of electronic media, comments, messages, and other social information

U.S. Application No.	86305251	Application Date	06/10/2014
----------------------	----------	------------------	------------

Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CAROUSEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Providing temporary use of non-downloadable software; providing temporary use of non-downloadable software for use in connection with data, photos, images, audio, video, and multimedia content; cloudcomputing services; social networking services; hosting of digital content on the internet; Providing temporary use of non-downloadable software for viewing, accessing, sorting, editing, manipulating, cataloguing, indexing, storing, syncing, uploading, downloading, sending, receiving, sharing, transferring, linking, tagging, streaming, and printing photos, images, graphics, videos, and other digital content, on, across, and via electronic devices, servers, global computer networks, and other communications networks; Providing temporary use of non-downloadable software for creating, viewing, saving, accessing, sorting, editing, manipulating, uploading, downloading, sending, receiving, sharing, transferring, posting, blogging, linking, tagging, and streaming, tags, albums, galleries, other metadata, electronic media, comments, messages, or other social information pertaining to photos and videos, on, across, and via electronic devices, servers, global computer networks, and other communications networks</p>		

Attachments	85411661#TMSN.png(bytes) 86250612#TMSN.png(bytes) 86305245#TMSN.png(bytes) 86305250#TMSN.png(bytes) 86305251#TMSN.png(bytes) zoosk_us ttab.pdf(79485 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/em/
Name	Eric J. Maiers
Date	09/29/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 86/111,135
Published April 1, 2014

Dropbox, Inc.)
)
 Opposer,)
)
 v.)
)
 Zoosk, Inc.)
)
 Applicant.)

STATEMENT OF GROUNDS UPON WHICH OPPOSITION IS BASED

As grounds for this opposition, it is alleged that:

1. Opposer Dropbox, Inc. (“Dropbox”) is the owner of United States Trademark Registration No. 4,330,190 for the mark CAROUSEL for downloadable software, specifically for enabling viewing and sharing of photographs across internet-enabled devices, in International Class 9 (the “CAROUSEL Registration”), which was registered on the Principal Register on May 7, 2013, based upon application Serial No. 85/411,661 filed in the United States Patent and Trademark Office on August 31, 2011.

2. The CAROUSEL Registration is in full force and effect and comprises *prima facie* evidence of the validity of the CAROUSEL mark, of Dropbox’s ownership thereof, and of Dropbox’s exclusive right to use the CAROUSEL mark in commerce and interstate commerce on or in connection with the goods or services specified in the Certificate of Registration, and as constructive notice of Dropbox’s claim of ownership under Title 15 U.S.C. §§ 1057, 1072, and 1115.

3. Additionally, Dropbox is the owner of the common law mark CAROUSEL for Computer software used to organize and share photographs and graphical content and create virtual photo albums; Downloadable software, specifically for enabling viewing and sharing of photographs across internet-enabled devices; Computer software; computer software for use in connection with data, photos, images, audio, video, and multimedia content; Computer software for viewing, accessing, sorting, editing, manipulating, cataloguing, indexing, storing, syncing, uploading, downloading, sending, receiving, sharing, transferring, linking, tagging, streaming, and printing photos, images, graphics, videos, and other digital content, on, across, and via electronic devices, servers, global computer networks, and other communications networks; Computer software for creating, viewing, saving, accessing, sorting, editing, manipulating, uploading, downloading, sending, receiving, sharing, transferring, posting, blogging, linking, tagging, and streaming tags, albums, galleries, other metadata, electronic media, comments, messages, or other social information on, across, and via electronic devices, servers, global computer networks, and other communications networks; Electronic storage of data, photos, images, graphics, audio, videos, and other digital content; electronic storage of tags, albums, galleries, and other metadata; electronic storage of electronic media, comments, messages, and other social information; Providing temporary use of non-downloadable software; providing temporary use of non-downloadable software for use in connection with data, photos, images, audio, video, and multimedia content; cloud computing services; social networking services; hosting of digital content on the internet; Providing temporary use of non-downloadable software for viewing, accessing, sorting, editing, manipulating,

cataloguing, indexing, storing, syncing, uploading, downloading, sending, receiving, sharing, transferring, linking, tagging, streaming, and printing photos, images, graphics, videos, and other digital content, on, across, and via electronic devices, servers, global computer networks, and other communications networks; Providing temporary use of non-downloadable software for creating, viewing, saving, accessing, sorting, editing, manipulating, uploading, downloading, sending, receiving, sharing, transferring, posting, blogging, linking, tagging, and streaming, tags, albums, galleries, other metadata, electronic media, comments, messages, or other social information pertaining to photos and videos, on, across, and via electronic devices, servers, global computer networks, and other communications networks. Applications for registration of this mark in association with the aforementioned goods and services were filed on April 12, 2014, and June 10, 2014, and given Trademark Serial Nos. 86/250612, 86/305245, 86/305250 and 86/305251 (collectively, “Dropbox’s Pending Applications”).

4. Dropbox or its predecessors in interest have used the CAROUSEL mark in interstate commerce, on its their and/or through their licensees, since at least as early as May 10, 2011.

5. Applicant Zoosk, Inc. (“Zoosk”), filed Application Serial No. 86/111,135 (“Zoosk’s Application”) on November 5, 2013, based on alleged use in commerce at least as early as October 24, 2012, towards registration of the proposed mark CAROUSEL for computer and mobile phone application software, namely, software for use in communicating, transmitting, and sharing audio, video, photos, text and other digital content; downloadable computer and mobile phone software for online introduction, dating and social networking services in International Class 9 (“Zoosk’s

Class 9 Goods”); for providing temporary use of nondownloadable software for use in communicating, transmitting, and sharing audio, video, photos, text and other digital content; providing temporary use of nondownloadable software for online introduction, dating and social networking services in International Class 42 (“Zoosk’s Class 42 Services”); and for online social networking services; online dating services, in International Class 45 (“Zoosk’s Class 45 Services”). Zoosk’s application was published for opposition on April 1, 2014.

6. Zoosk’s proposed CAROUSEL mark is identical to Dropbox’s registered and common law CAROUSEL mark.

7. Zoosk’s goods and services for which it is attempting to register its proposed CAROUSEL mark overlap with Dropbox’s goods and services associated with its CAROUSEL marks. Specifically, portions of the goods and services in Zoosk’s junior application fail to exclude particular channels of trade or classes of consumers or otherwise reduce or eliminate the likelihood of confusion with the identification of goods in Dropbox’s senior registration.

8. Accordingly, in the absence of an agreement between the parties establishing their respective rights and obligations, there exists a substantial likelihood of confusion between Zoosk’s proposed CAROUSEL mark and Dropbox’s registered and common law CAROUSEL mark, should Zoosk’s application claiming Zoosk’s Class 9 Goods and Zoosk’s Class 42 Services be permitted to proceed to registration.

9. Further, the USPTO has provisionally cited Zoosk’s Application in three of Dropbox’s Pending Applications as being a potential grounds to refuse registration of those three of Dropbox’s Pending Applications under Section 2(d) of the Trademark Act,

if Zoosk's Application matures into a registration. Accordingly, Dropbox has already been harmed by Zoosk's Application, and such harm will continue if Zoosk's Application is permitted to register.

WHEREFORE, Dropbox prays that application Serial No. 86/111,135 be rejected, that no registration be issued to Zoosk, and that this Opposition be sustained in favor of Dropbox.

The fee required under 37 C.F.R. §2.6(a)(17) in the amount of \$300.00 has been paid via deposit account.

Respectfully submitted,

GREENBERG TRAUIG, LLP

Dated: September 28, 2014

/s/ Eric J. Maiers

One of Attorneys for Dropbox

Susan Heller
GREENBERG TRAUIG, LLP
1840 Century Park East, Suite 1900
Los Angeles, CA 90067
(310) 586-6568

Eric J. Maiers
GREENBERG TRAUIG, LLP
77 West Wacker Drive, Suite 3100
Chicago, IL 60601
(312) 456-1036

CERTIFICATE OF ELECTRONIC FILING

The undersigned hereby certifies that this document is being electronically filed on September 29, 2014 with the United States Patent and Trademark Office.

/s/ Grace Linker
Grace Linker

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing STATEMENT OF GROUNDS UPON WHICH OPPOSITION IS BASED has been served via first class mail, postage pre-paid, on September 29, 2014, to:

Aaron D. Hendelman
Wilson Sonsini Goodrich & Rosati
650 Page Mill Rd
Palo Alto, CA 94304-1050

/s/ Grace Linker
Grace Linker